

REMARKS

Status of Claims

The Office Action of January 29, 2008, 2007 presents the examination of claims 8-10, 17, and 20-23. Claims 11-13, 18, 19, 24 and 25 are withdrawn. Claim 20 is indicated as allowable if rewritten into independent form incorporating the features of intervening claims.

The present paper cancels claims 17 and 20. The subject matter of allowable claim 20 is incorporated into independent claim 8. Applicants reserve the right to file an application directed to the subject matter of canceled claim 17 pursuant to 35 USC § 120.

Claim 9 is amended to independent form to recite a second species that Applicants submit is patentable. Support for the amendment to claim 9 is provided by the compounds DM-02 and DM-03 at page 54 of the specification. **In view of allowability of claim 20 (now claim 8), the Examiner is requested to examine a second species of the invention with an eye toward determining if a generic claim (e.g. claim 11) is patentable.**

Independent claim 11 is amended to incorporate the feature of allowable claim 20, and to delete additional subject matter indicated by the Examiner to encompass prior art, or which might otherwise encompass prior art.

The Examiner asserts that claim 21 is directed to an invention that is independent or distinct from the invention originally elected, in that, "original claims require [the] methyl group connected to the nitrogen of dextromethorphan to be substituted with [an] alkyl group bearing a nitrogen-containing heterocycle group. The Examiner asserts that the compounds of claim 21 do not have said methyl group substituted with an alkyl group bearing a nitrogen-containing heterocycle group.

The Examiner has misread the claims. Claim 8 recites, and always has, that the methyl group substituting the nitrogen of dextromethorphan is substituted “by”, that is, the methyl group is replaced by, a ‘...a C₁₋₆ alkyl group bearing ...’. Accordingly, the subject matter of claim 21 is within the subject matter that should have been examined during the prosecution of the present application. Examination of claim 21 is respectfully requested.

Anticipation by Wu

The Examiner maintains the rejection of claims 8, 9 and 17 under 35 USC § 102(e) over Wu et al. US 2005107415 (“Wu ‘415”). The rejection is moot as to claim 17, which is canceled. As to claim 8, this claim has been amended so as to recite subject matter deemed allowable by the Examiner. These rejections are respectfully traversed as to claim 9. Reconsideration and withdrawal thereof are requested.

As to claim 9, first, the Examiner has not addressed Applicants’ argument regarding the lack of specificity of the disclosure of Wu. That is, as previously explained,

The reference describes at least four distinct core structures (formulae I, II, III and IV). Furthermore, each of those core structures is disclosed as derivatized at either of two positions (R and X). Eleven fundamental possibilities are given for R (see paragraph 22), six of which include a further substituent having a “ring”, which ring is further defined only by examples of three fundamentals, each of which can be “substituted” by myriad possibilities. The possibilities for X go on for two full paragraphs. (See, paragraphs 24-25.) Therefore, Wu ‘415 discloses hundreds, if not thousands or tens of thousands, of compounds. There is no disclosure in Wu ‘415 specifically pointing the artisan to dextromethorphan derivatives having the amino methyl group replaced by a nitrogen-containing heterocyclic group. Furthermore, Wu ‘415 seeks morphine antagonists, not non-competitive inhibitors of a ligand-gated neurotransmitter receptor. Thus, Wu ‘415 fails to urge either the particular structure of the compounds of the present invention or the function of such compounds.

Disclosure of any particular dextromethorphan derivative having a heterocyclic amine at the nitrogen atom is not provided in the priority application.

Again, for a reference to be anticipating, there must be particularized disclosure of the specific compound or genus claimed. It is not sufficient that the compound of an application can be assembled from generic disclosure of each of the possible groups appended to a structure. See, *e.g. In re Petering*, 133 USPQ 275 (CCPA 1962); *In re Ruschig*, 145 USPQ 274 (CCPA 1965). Under the rule established by *Petering* and *Ruschig*, Wu '415 is not a reference that anticipates the present invention, and so this rejection must be withdrawn.

As to claim 9, the Examiner has not explained how Wu '415 discloses a keto-containing group as the substituent at the nitrogen of dextromethorphan.

Anticipation by Grussner

Claims 8, 9 and 17 are rejected under 35 USC § 102(b) over Grussner US 297-147 ("Grussner '147"). Claim 17 is canceled, rendering this rejection moot as to this claim. As to claim 8, this claim has been amended so as to recite subject matter deemed allowable by the Examiner. These rejections are respectfully traversed as to claim 9. Reconsideration and withdrawal thereof are requested.

At the very least, Grussner '147 does not disclose dextromethorphan derivatives; the 3 carbon is substituted by a hydroxyl, not a methoxyl, group. Therefore, Grussner '147 does not anticipate the present claims and the instant rejection must be withdrawn. The Examiner's comment that the claims are silent with respect to dextromethorphan derivatives at the 3 position is not understood. As the elected species, dextromethorphan derivatized at the nitrogen is clearly stated in the claims.

Applicants do understand that (withdrawn) generic claim 11 is not so limited. In regard to claim 11, Applicants understand that the reference discloses a compound in which the N-methyl group of a multiple ring heterocycle is substituted by a C1-C6 alkyl group having a pyridyl group. Claim 11 now recites that group as one that has an imidazolidine group (indicated as allowable in combination with dextromethorphan) or a keto group. Such excludes a pyridyl

group from the claim and so claim 11 and claims dependent thereon are free of the instant rejection.

Furthermore, as to both of claims 9 and 11, Grussner '147 does not disclose that the substituent of the ring nitrogen should be one containing a keto group. Accordingly, the instant rejection should be withdrawn for this additional reason.

Anticipation by Eddy

Claims 8-10 and 17 are rejected under 35 USC § 102(b) or 103(a) over Eddy et al., Bulletin of Narcotics, 10:23-41 (1958) ("Eddy (1958)"). Claims 10 and 17 are canceled, rendering this rejection moot as to these claims. As to claim 8, this claim has been amended so as to recite subject matter deemed allowable by the Examiner. These rejections are respectfully traversed as to claim 9. Reconsideration and withdrawal thereof are requested.

The Examiner has not explained how Eddy (1958) discloses or suggests dextromethorphan having the ring nitrogen substituted by C1-C6 alkyl bearing an imidazolidine or keto group. Accordingly, claim 9 is not anticipated by or obvious over Eddy (1958) and these rejections should be withdrawn.

Rejections for Obviousness

Claims 22 and 23 are rejected under 35 USC § 103(a) over any one of Wu '415, Grussner '147 or Eddy (1958). These rejections are respectfully traversed. Reconsideration and withdrawal thereof are requested.

Claim 8 is amended to recite subject matter deemed allowable over the prior art of record. Claims 22 and 23, dependent from claim 8, should now be found allowable also.

Applicants submit that the present application claims allowable subject matter. The favorable actions of withdrawal of the instant rejections, consideration of the additional species

recited in claim 9 and of the generic claims 11, etc. and allowance of the application, are requested.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Mark Nuell, Registration No 36,623 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

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Respectfully submitted,

By


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